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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,584	08/30/2000	Howard N. Straub	RES-101A	9208

7590

12/28/2004

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EXAMINER
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BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/650,584

Applicant(s)

STRAUB, HOWARD N.

Examiner

Vy Q. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8,11,12,17 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8,11,12,17 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5, 8, 11-12, 24-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by WONG-4,521,210.

As to claims 1-2, 5, 8, 11-12, 24-27 and 29, WONG (Figs. 3A-3C, 11-12) discloses a T-shaped stent including cross portion 40 and leg portion 42 having a bottom surface with an arcuate portion, a tapered planar portion 50 and a substantially flat portion at the bottom of cross portion 40 as claimed. The functional languages in the claims have been considered but not given much patentable weight because they indicate the intended use of the device only, and do not provide any further structural limitation to the device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, 17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over WONG-4,521,210.

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As to claims 3 and 28, WONG discloses a T-shaped stent having substantially every limitation as claimed, except for a base curve of about 8-9mm and the top surface of the elongated portion is narrower than the bottom surface as claimed. It would have been an obvious matter of design choice to provide WONG device a base curve as recited in the claim, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

As to claim 6, PMMA is a well-known stiff polymeric material suitable for making an eye implant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make WONG stent of PMMA for PMMA is a well known material suitable for making an eye implant.

As to claim 17, WONG discloses a T-shaped stent having substantially every limitation as claimed, except for placing four of them in a sclera. However for device claims, patentability weight of a device or a plurality of the device cannot be based on the intended use of the device(s).

### ***Specification***

The disclosure is objected to because there is at least a typo error, such as: "leg portion (6)" on line 11, page 15 should have been – leg portion (4)--. Correction is required. See MPEP § 608.01(b).

### ***Response to Arguments***

Applicant's arguments filed 9/7/2004 have been fully considered but they are not persuasive.

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As to claim 1, the Applicant argued that claim 1 is not an anticipation of Wong for two reasons:

First, Wong does not teach providing an arcuate portion having a curvature greater than a radius of curvature of the globe in the area of the tunnel" of the eye, as recited in Claim 1. Instead, Wong discloses an implant matching the curvature of the sclera of the eye. See the Abstract of Wong. Column 2, lines 24-25, of Wong describe an implant curved to follow the configuration of the limbal region of the eye." Therefore, Wong does not teach a curvature greater than a radius of curvature of the globe in the area of the tunnel.

Secondly, Applicant notes that Claim 1 is directed to a scleral-tensioning stent. Applicant notes that Wong does not disclose such a stent, and is therefore also insufficient to sustain the rejection under 35 USC 102 of Claim 1.

As to claim 17, the Applicant argued that claim 17 is not an obvious modification of WONG device because the claim recites "torsional resistant sclera-tensioning stents and how such stents are located in relation to each other".

In response, first, the Applicant is noted that a globe curvature of an eye is a variable dependent on each individual patient. Therefore, as to claim 1, a claimed device read on a WONG device having a specific curvature C1 (for example) can be used as a scleral-tensioning stent for an eye having a globe curvature C2 as long as  $C2 < C1$ . Secondly, as to claim 1 and claim 17, the claimed device read on WONG device or a modified WONG device, except for the difference in the intended use of the device (scleral-tensioning stent). Without any structural limitation to distinguish the claimed invention from a WONG device, which is also used for implanting in an eye, it is reasonable to one of ordinary skill in the art to conclude that WONG device is also capable of doing the same function(s) as the device recited in the claims.

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***Information Disclosure Statement***

The IDS in the CD has been ordered to the Examiner location and will be initialized and mailed to the applicant when the CD has been received and reviewed by the Examiner.

***Conclusion***

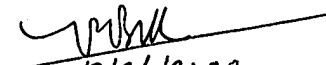
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
12/26/2009  
Vy Q. Bui  
Primary Examiner  
Art Unit 3731